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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------------|
| 10/706,427 | 11/12/2003 | James R. January | 14045.015US | 7160 |
| 22870 7590 01/08/2007 LAURENCE P. COLTON 1201 WEST PEACHTREE STREET, NW 14TH FLOOR ATLANTA, GA 30309-3488 | | | EXAMINER MATZEK, MATTHEW D | |
| | | | ART UNIT 1771 | PAPER NUMBER |
| | | | MAIL DATE 01/08/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

✓

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/706,427

Applicant(s)

JANUARY, JAMES R.

Examiner

Matthew D. Matzek

Art Unit

1771

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-5 and 7-23.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


NORCA TORRES
PRIMARY EXAMINER
12/29/06

Continuation of 11. does NOT place the application in condition for allowance because: Claims 1-5 are rejected under 112 2nd paragraph for lack of antecedent basis for the use of the term "paint mixture" in claim 1. Claim 7 is rejected under 112 2nd paragraph as it is dependent upon canceled claim 6. Claims 1-5, 7-12, 14-17 and 19-22 are rejected under 35 U.S.C. 102(b) for reasons of Record and claims 13, 18 and 23 are rejected under 35 U.S.C. 103(a) for reasons of Record. Examiner has considered the 1.132 declaration provided by Applicant, but finds it unpersuasive. Applicant argues that the Lovell patent is not in the same technical field of endeavor. Examiner agrees that the instantly claimed invention and that of Lovell are from different fields of endeavor, however the inventions have the same compositional make-up and as pointed out in the Office Action dated 1/9/2006 and the specific percentages as claimed would have been obvious to one having ordinary skill in the art at the time of the invention was made through routine experimentation in a desire to optimize said composition. Applicant argues that graphite is not a pigment and that Lovell does recite his use of graphite as a pigment. Lovell describes the use of carbon black for the specific use of pigmentation (col. 7, lines 19-40). In addition, graphite may be used as a pigment in graphitic drawing pencils. Applicant argues that Lovell fails to mention the terms "watercolor", "supports" or "media for watercolor techniques". The invention of Lovell sets forth the composition and structure that is instantly claimed. Therefore, it may function as a coated substrate for watercolor techniques. Applicant argues that the water-soluble polymer of Lovell is not added to the coating formulation and by not doing this it only makes the coating stick better to the substrate rather than making the coating perform better. The instant claims recite a coated substrate which is anticipated by Lovell. Applicant has failed to distinguish how the structure of the currently claimed article is different than that of Lovell. Applicant argues that Lovell makes no mention of pigment dispersant, calcium carbonate or water soluble polymer. Lovell describes the use of pigment dispersant (col. 5, lines 52-55), calcium carbonate (col. 6, lines 17-25) and water soluble polymer (col. 5, lines 13-22). Applicant argues that Lovell fails to mention relative quantities of defoamer, surfactant and extender relative to the overall coating. The concentration of the defoamer, surfactant and extender relative to the overall coating may not be mentioned, however it has been calculated and shown on page 5 of the Office Action dated 1/9/2006. In the Remarks section dated 12/12/2006 Applicant argues that the instant invention and that of Lovell are from different fields of endeavor. This argument has been addressed supra. Applicant argues that graphite is not to be used as a pigment. This argument has been addressed supra.